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1 UNITED STATES PATENT AND TRADEMARK OFFICE
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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* ANTHONY R. ROTHSCHILD
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11 Appeal 2011-001313
12 Application 09/755,541
13 Technology Center 3600
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17 Before ANTON W. FETTING, MEREDITH C. PETRAVICK, and
18 MICHAEL W. KIM, *Administrative Patent Judges*.

19
20 FETTING, *Administrative Patent Judge*.

21 DECISION ON APPEAL
22

STATEMENT OF THE CASE¹

Anthony R. Rothschild (Appellant) seeks review under 35 U.S.C. § 134 (2002) of a final rejection of claims 62, 65, 68-70, 73, 75-77, 81, 84, 86-90, and 92-95, the only claims pending in the application on appeal. Oral arguments were presented on March 8, 2011. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellant invented a way of advertising over a wide area network such as the Internet that allows an Internet user to place an advertisement within a personal communication, and provides a recipient of the personal communication requesting additional information with such information regardless of the network device the recipient is using (Specification 1:18-22).

An understanding of the invention can be derived from a reading of exemplary claim 62, which is reproduced below [bracketed matter and some paragraphing added].

62. A Web host connected to a wide area network (WAN),
comprising:

[1] a Web server adapted to communicate with a plurality of
network devices via said WAN;

[2] a memory device connected to said Web server and adapted
to store a plurality of advertisements;

and

[3] an advertising application,

¹ Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed February 9, 2010) and Reply Brief ("Reply Br.," filed October 20, 2010), and the Examiner's Answer ("Ans.," mailed August 20, 2010).

wherein said advertising application provides the
functions of:

- [4] permitting a sender
 - to submit communication data
 - to said Web host
 - and
 - to identify at least one recipient
 - of said communication data;
- [5] using at least a portion of the content of said
communication data
 - to automatically select at least one
advertisement
 - from said plurality of advertisements;
- [6] inserting
 - said at least one advertisement
 - and
 - said communication data
 - into a personal electronic communication,
 - wherein said personal electronic
communication comprises an e-mail
message;
- [7] sending said personal electronic
communication
 - to said at least one recipient
 - via said WAN;
- and
- [8] compensating said sender
 - by providing said sender
 - with a free service

in exchange for allowing said Web host to
send said personal electronic
communication,
including said at least one
advertisement,
to said at least one recipient.

The Examiner relies upon the following prior art:

Gabbard	US 6,205,432 B1	Mar. 20, 2001
Roth	US 6,285,987 B1	Sep. 4, 2001

Claims 62, 65, 68-70, 73, 75-77, 81, 84, 86-90, and 92-95 stand rejected
under 35 U.S.C. § 103(a) as unpatentable over Gabbard and Roth.

ISSUES

The issues of obviousness turn primarily on whether it was predictable to
select an ad based on textual content and embed such an ad in an email.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be
supported by a preponderance of the evidence.

Facts Related to the Prior Art

Gabbard

01. Gabbard is directed to an advertisement system and method for
inserting into an end user communication message a background
reference to an advertisement causing an advertisement image to
be tiled, or watermarked, across an end user screen behind the text
of an e-mail message or public posting. The message server

1 receives an SMTP or NNTP message and transmits an SMTP,
2 POP3 or NNTP message with an HTML portion for a respective
3 HTML-compatible client. Alternately, the message server
4 transmits the entire message in HTML to be used as a stand-alone
5 web page or as a portion of a larger page employing frames or
6 tables. Gabbard 4:6-67.

7 02.Gabbard describes offering a free web-email service in return for
8 using this service. Gabbard 10:8.

9 *Roth*

10 03.Roth is directed to providing advertisements from a central server
11 to viewers who access web sites. A data base includes
12 information about viewers, information about the characteristics
13 of particular web sites and other information relevant to which
14 advertisements should be displayed for particular viewers. Roth
15 evaluates, in real time, bids submitted by different advertisers in
16 order to determine which particular advertisement will be
17 displayed to a viewer. Roth 1:66 – 2:10.

18 04.The fact that a viewer has accessed a web page which has an
19 HTML reference to the advertising server is referred to as a view
20 opportunity or view-op. The characteristics of each view-op
21 include the *characteristics of the particular web site and web page*
22 *being accessed* and the characteristics of the viewer including
23 demographic information about the viewer and information as to
24 what other sites this viewer has accessed in various periods of
25 time. Roth 2:11-19.

05. Each advertiser provides one or more "proposed bids" which specify how much the advertiser is willing to pay for displaying a particular advertisement in response to a view-op with certain characteristics. Each proposed bid can specify a price or amount that the advertiser is willing to pay for the opportunity to display an advertisement (a) to a viewer who has a particular set of characteristics and (b) on a web site and web page that meets a particular set of criteria. Each proposed bid can be dependent upon or require satisfaction of various criteria which must be met in order for a bid of a particular amount to be submitted. Roth 2:20-47.

06. When a view-op arises, the bidding agents evaluate the characteristics of the view-op compared to the specifications in proposed bids and the bidding agents submit bids to the bid selection logic where appropriate. Next, the bid selection logic selects the highest bid from the various available bids and the advertisement which is specified in the highest bid is displayed. Roth 2:54-65.

07. Roth describes *using words that must be on the page viewed as criteria for ad bidding*. Roth 14:23-24.

ANALYSIS

The Examiner applied Gabbard to show it was known to insert an ad in an e-mail (FF 01) and applied Roth to show it was known to rely on content to select an ad (FF 03-07). We find the Examiner has completely and properly responded to the arguments in the Appeal Brief. Consequently, we

1 adopt the Examiner's findings of fact and analysis from Answer 3-14 and
2 reach similar legal conclusions. The issues thus reduce down to those
3 presented in the Reply Brief.

4 We are not persuaded by the Appellant's argument that

5 Roth does not use content data to select an advertisement from
6 a plurality of advertisements, wherein the selected
7 advertisement is inserted into a web page

8 Reply Br. 3-7. Appellant contends that Roth relies on bids to select ads.
9 These bids, however, are formed based on criteria including page content.
10 FF 04-07. The limitation at issue is "using at least a portion of the content of
11 said communication data to automatically select at least one advertisement."
12 There is no further narrowing of the manner or level of use. Clearly using a
13 portion of the content to form a bid which in turn is used to select an
14 advertisement is within the scope of the claimed use.

15 We are not persuaded by the Appellant's argument that

16 [i]t would not have been obvious to combine the Internet
17 advertising system of Roth with the email advertising system of
18 Gabbard

19 Reply Br. 7-14. Again, the Examiner applied Gabbard to show it was
20 known to insert an ad into an e-mail and Roth to show it was known to select
21 the ad based on the textual content of a message. Roth is directed to
22 selecting an ad for internet usage, and Gabbard is directed to imbedding such
23 an ad in an email. Thus, Roth is directed to ad selection and Gabbard to ad
24 delivery. One of ordinary skill in the marketing arts knew that both
25 selecting the appropriate ad and delivery vehicle were critical in ad
26 effectiveness. Thus, it was predictable to select references that described

1 each of ad selection and delivery, and apply both to ensure such
2 effectiveness.

3 The Appellant also contends as part of this argument, that one of
4 ordinary skill would not have known how to extract the words in Gabbard's
5 email for use in Roth's selection criteria. The Examiner found that simple
6 parsing would do so. Appellant contends there is no evidence that one of
7 ordinary skill knew how to perform such parsing.

8 The Examiner was simply taking notice of the fact that parsing is one of
9 the first techniques undergraduate computer science majors learn, and is
10 typically a freshman or sophomore level exercise. One of ordinary skill out
11 of school and practicing the internet programming arts would have been all
12 too familiar with parsing text to extract words. This is in fact evidenced by
13 Roth's very use of web pages and Gabbard's very use of email. Web pages
14 are written in HTML, which requires parsing to display on a screen. Email
15 contains fields directing the message to a particular computer and user, also
16 requiring parsing to extract the data in the fields.

17 We are not persuaded by the Appellant's claim 88 argument that

18 THE PRIOR ART DOES NOT DISCLOSE USING
19 CONTENT OF AN EMAIL AND ADVERTISEMENT-TYPE
20 DATA TO SELECT AN ADVERTISEMENT FROM A
21 PLURALITY OF ADVERTISEMENTS AND INSERTING
22 THE SELECTED ADVERTISEMENT INTO THE EMAIL

23 Reply Br. 15-17. This argument is similar to that made in support of
24 claim 62. Claim 88 depends from claim 87, also similar to claim 62, and
25 recites further

26 allowing a sender to select a type of advertisement that can be
27 included in said personal communication by submitting

advertisement-type data, said sender-provided data further comprising said advertisement-type data; and using said at least a portion of said communication data and said advertisement-type data to select said at least one of said plurality of advertisements.

Appellant contends that Roth's user is not the sender. That is not the issue. Gabbard clearly has two senders, the party sending the email and the party embedding the ad which is also sent. The party who selects the ad to be sent is a sender at least in the sense the ad selected by that party is sent.

CONCLUSIONS OF LAW

The rejection of claims 62, 65, 68-70, 73, 75-77, 81, 84, 86-90, and 92-95 under 35 U.S.C. § 103(a) as unpatentable over Gabbard and Roth is proper.

DECISION

The rejection of claims 62, 65, 68-70, 73, 75-77, 81, 84, 86-90, and 92-95 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

MP